

REMARKS

Claims 1 through 55 are currently pending in the application.

Claims 6 through 55 are withdrawn from consideration as being directed to a non-elected invention. Claims 1 through 5 stand rejected.

This amendment is in response to the Office Action of May 15, 2003.

Applicant notes the filing of an Information Disclosure Statement herein on June 25, 2001 and notes that the copy of the PTO-1449 returned with the outstanding Office was not initialed by the Examiner. Applicant respectfully requests that the information cited on the PTO-1449 (which is the same as that of record to that date in the parent application hereto) be made of record herein.

Claims 1 through 3 and 5 are rejected under 35 U.S.C. § 102(b) as being anticipated by Bierig (U.S. Patent 4,089,734).

Claim 4 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Bierig (U.S. Patent 4,089,734) in view of Maruyama et al. (U.S. Patent 5,832,595).

After carefully considering the cited prior art, the rejections, and the Examiner's comments, Applicant has amended the claimed invention to clearly distinguish over the cited prior art.

Applicant submits that a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Brothers v. Union Oil Co. of California*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). The identical invention must be shown in as complete detail as is contained in the claim. *Richardson v. Suzuki Motor Co.*, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

Applicant submits that presently amended independent claim 1 is not and cannot be anticipated by the Bierig reference because the Bierig reference does not identically describe each and every element as is presently set forth in the claim, either expressly or inherently described, in as complete detail as is contained in the claim. More specifically, the Bierig reference does not describe either explicitly or inherently the elements of the presently claimed invention calling for "providing a plurality of fuse elements in respective electrical communication with at least some of the plurality of conductive traces, at least some of the plurality of fuse elements

disposed immediately adjacent the at least one of the first surface and the second surface, at least some of said plurality of fuse elements comprising at least two types of fuses of an active fuse element, a passive fuse element, a self-resetting fuse element, a repairable fuse element, and a replaceable fuse element”. Applicant submits that the Bierig reference only describes a single type of fuse element, not a multiplicity of types of fuse elements. Accordingly, the Bierig reference cannot and does not anticipate the presently claimed invention of amended independent claim 1 under 35 U.S.C. § 102. Therefore, presently amended independent claim 1 is allowable as well as dependent claims 2 through 4 therefrom.

Applicant further submits that to establish a *prima facie* case of obviousness under 35 U.S.C. § 103 three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Third, the cited prior art reference must teach or suggest all of the claim limitations. Furthermore, the suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on Applicant’s disclosure.

At the very least, Applicant submits that any combination of the cited prior art Bierig reference and the Maruyama et al. reference does not and cannot establish a *prima facie* case of obviousness under 35 U.S.C. § 103 because any combination of the cited prior art fails to teach or suggest all the claim limitations of the presently claimed invention. More specifically, any combination of the cited prior art fails to teach or suggest the claim limitations of presently amended independent claim 1 calling for “providing a plurality of fuse elements in respective electrical communication with at least some of the plurality of conductive traces, at least some of the plurality of fuse elements disposed immediately adjacent the at least one of the first surface and the second surface, at least some of said plurality of fuse elements comprising at least two types of fuses of an active fuse element, a passive fuse element, a self-resetting fuse element, a repairable fuse element, and a replaceable fuse element”. As is noted in the Office Action, the Maruyama et al. reference is cited for the use of copper as a fuse element. Any combination of the Bierig reference and the Maruyama et al. reference cannot and does not establish a *prima*

facie case of obviousness under 35 U.S.C. § 103 because neither cited prior art reference nor any combination thereof teaches or suggests the present claim limitations of independent claim 1. Accordingly, any combination of the cited prior art cannot and does not teach or suggest the claim limitations of dependent claim 4 from presently amended independent claim 1. Therefore, claim 4 is allowable.

For the reasons herein, Applicant submits that claims 1 through 5 are clearly allowable over the cited prior art.

Applicant requests the allowance of claims 1 through 5 and the case passed for issue.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "James R. Duzan", with a long, sweeping horizontal stroke extending to the right.

James R. Duzan
Registration No. 28,393
Attorney for Applicant
TRASKBRITT
P.O. Box 2550
Salt Lake City, Utah 84110-2550
Telephone: 801-532-1922

Date: July 21, 2003

JRD/sls:djp

Document in ProLaw